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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,046	11/04/2003	Ikuya N. Nagai	66396-068	3127

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Washington, DC 20005-3096

EXAMINER

BEAULIEU, YONEL

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/700,046

Applicant(s)

NAGAI ET AL.

Examiner

Yonel Beaulieu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-27 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/6/04 & 11/04/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Drawings

Figures 1 - 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated (note Applicant's disclosure at ¶¶ 0021 – 0023 and 0043 at least). See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 7 – 9 are objected to because of the following informalities: line 9 of claim 7 appears incomplete; particularly, the phrase "...and detection the other selected...". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 4, 6, 7, 10 – 15, 17 – 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Thompson (US 6,529,620 B2).

Regarding claims 1, 3, 7, 17, 20, 21, and 24 - 27, Thompson teaches a method of and a product for capturing measurement data for a plurality of physical parameters measured during a test using a meter/diagnostic tool (20), comprising receiving (via item 20; see fig. 1) a selection of parameter from the plurality from a user (50; fig. 2) and receiving a selection of a condition with respect to the selected parameter (col. 5, lines 4 – 13 at least); processing (using CPU 92) measurement data and analyzing a relationship of the measurement data for the selected parameter to the selected condition and triggering capture of measurement data for the plurality of physical parameters for review/replay by the user (abstract; col. 5, lines 54 – 67; col. 6, lines 41 – 67; col. 7, line 61 – col. 8, line 16 and col. 8, line 32 – 37 at least); and a display for visual output of graphs (patterns) of measured data for the parameters (col. 10, lines 6 – 38 at least).

Regarding claims 2, 4 and 6, Thompson further teaches diagnostic signals including a plurality of trouble codes (abstract; col. 4, lines 44 – 60; col. 6, lines 11 – 28 at least).

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Regarding claims 10 and 15, Thompson further teaches the measurement taking place over a predetermined period of time (abstract; col. 4, lines 45 – 60 at least).

Regarding claims 11, 12, 18, and 19, Thompson further teaches the operational parameters being operational parameters of a vehicle and engine performance parameter (col. 4, lines 39 – 44; col. 6, lines 41 – 55 at least).

Regarding claims 13, 14, 22, and 23, Thompson further teaches buffering the measurement data (col. 12, lines 14 – 28 at least).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson ('620) in view of Simon, Jr. et al. (US 5,186,080).

As discussed above, Thompson teaches all of the limitations except for the explicit recitation that the selected parameter relating to a predetermined speed.

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However, Simon teaches, in the same field of endeavor of monitoring/capturing physical parameters, a selected parameter relating to a predetermined speed (col. 3, line 58 – col. 4, line 7 at least).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Thompson's teaching by including a selected parameter relating to a predetermined speed as evidenced by Simon, Jr. et al. in order to achieve a desired engine operating condition.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson ('620).

As discussed above, Thompson teaches all of the limitations except for the selected relationship of the selected conditions being a concurrent Boolean logic relationship in a predetermined consecutive order.

However, Thompson has been shown to suggest other software capable of achieving what is claimed (note Thompson's col. 12, lines 14 – 28 at least). It would have been obvious to one of ordinary skill in the art at the time of the invention Thompson's teaching is at least fully functionally equivalent to the logic relationship claimed because the same end result is achieved.

Allowable Subject Matter

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yonel Beaulieu whose telephone number is (571) 272-6955. The examiner can normally be reached on M-W 9-3; F 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas BLACK can be reached on (571) 272-6956. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Y. BEAULIEU
AU 3661


YONEL BEAULIEU
PRIMARY EXAMINER